

Remarks

This is a complete response to the Office Action mailed March 20, 2006. These amendments and remarks are proper and do not add new matter, but rather clarify Applicant's position that all claims are in condition for allowance.

In the event that the Examiner does not grant reconsideration of the final rejection as requested by Applicant herein, the remarks further serve to explain why this case is not in condition for appeal.

Claim Objection

Claims 18 and 20 stand objected to because claim 18 had a dangling “; and” at the end of the claim. Claim 18 has been amended herein to obviate the objection. Withdrawal of the objection is respectfully requested.

Rejection Under Sections 102/103

Claims 9, 11, and 14-16 stand rejected as being anticipated by, or in the alternative obvious in view of, Stamos '914. This rejection is again respectfully traversed.

Claim 9

Applicant reiterates that Stamos '914 neither identically discloses nor teaches/suggests *a backplane support fixed to the backend partition and adapted for operably fixing a backplane to the backplane support* as claimed. (see Applicant's Response filed 12/20/2005, ppg. 10-12)

In “reading” this claim feature onto Stamos '914, the Examiner's own citation of Stamos '914 explicitly points out that its backplane 42 is compressingly sandwiched

between the chassis 28 and the sub-chassis 46, and not fixed to either one as presently claimed.

The present embodiments as claimed are patentably distinguishable over Stamos '914 which does not disclose or teach/suggest fixing the backplane to the removable partition. Applicant further reiterates, as attested to in the previously filed inventor's declaration, that the present embodiments as claimed solves an inherent problem with the structure of Stamos '914. That is, the free-floating backplane structure in Stamos '914, with components connected on opposing sides thereof, is likely to cause damage to the backplane and/or to the components as the sub-chassis 46 is removed.

The Examiner has failed to substantiate a prima facie case of anticipation because Stamos '914 does not identically disclose all the features of the present embodiments as recited by the language of claim 9. Thus, the examination resulting in the present anticipatory rejection is incomplete with regard to the Examiner's obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a) Accordingly, this case is not in condition for appeal until this factual issue is resolved by the Examiner either withdrawing the anticipatory rejection or substantiating it factually in the record.

The Examiner has also failed to substantiate a prima facie case of obviousness because Stamos '914 does not teach or suggest all the features of the present embodiments as recited by the language of claim 9. Thus, the examination resulting in the present obviousness rejection is incomplete with regard to the Examiner's obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a) Accordingly, this case is not in condition for appeal until this factual issue is resolved by the Examiner either withdrawing the obviousness rejection or substantiating it factually in the record.

The Examiner has also failed to substantiate a *prima facie* case of obviousness by failing to substantiate a factual basis motivating a skilled artisan to modify Stamos '914 to arrive at the present embodiments as claimed. To that end the Examiner stated:

Stamos teaches an enclosure having a removable backend partition and a backplane support. The reference does not specifically teach the removable backend partition and the backplane support as separate structures, but does teach an upper portion of 46 and the lower portion of 46 "fixed" together. See Fig. 4A, which shows screw holes or weld points on the side of the backend partition and between the upper and lower portion(s) of 46.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the backend partition to include separate upper and lower portions that are fixed or joined together, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179 (Office Action of 3/20/2006, pg. 3)

However, whether the sub-chassis 46 of Stamos '914 is made integrally or not is wholly irrelevant to *fixing a backplane to the backplane support* as claimed. Obviousness under Section 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). Absent the requested reconsideration, a Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the legal conclusion of obviousness. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

For a *prima facie* case of obviousness to exist, there must be an objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that

would lead an individual to modify and/or combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The motivation may come explicitly from statements in the prior art, from knowledge of one of ordinary skill in the art, or even in the nature of the problem to be solved. *Kotzab*, at 1370. The presence or absence of motivation is a question of fact, and the evidence that motivation exists must be clear and particular. *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999). To send this case to appeal the Pre-Appeal Brief Panel must find concrete evidence in the record to support the prima facie case, rather than relying on what the Examiner views to be “well recognized” or what a skilled artisan would be “well aware of.” *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001)

In this case, there is absolutely no evidence in the record – only the Examiner’s irrelevant statement having nothing to do with *fixing a backplane to the backplane support* as claimed.

Accordingly, this case is not in condition for appeal due to the unresolved factual issues that the Examiner has failed to substantiate any prima facie case whatsoever. Accordingly, for at least these reasons withdrawal of the final rejection of claim 9 and the claims depending therefrom is respectfully requested for further prosecution on the merits to completion.

Rejection Under 35 USC 103

Claims 1, 2, 4-8, 12, 13, 17, and 18 stand rejected as being unpatentable over Stamos ‘914 in view of Creason ‘150. This rejection is respectfully traversed.

Claim 1

Applicant agrees with the Examiner to the extent that "Stamos does not teach the system having a multiple device array as claimed." (Office Action of 3/20/2006, pg. 4)

However, Creason '150 does not cure the deficiency of Stamos '914 in that it does not teach or suggest *a plurality of data storage devices that are electrically connected to a common connector, whereas the carrier is operably slidingly engageable in the frontend partition toward the backplane to connect the common connector to the other side of the backplane* as claimed.

The Examiner mischaracterized Creason '150 in order to "read" its power filter 139 onto the *common connector* of the present embodiments. (Office Action of 3/20/2006, pg. 5) A plain reading of Creason '150 reveals that its power supplies 602, 702, not its data storage devices 212, 214, are connected to the power filter 139: "The drawer or subchassis 200 further shows power filters 139 which mate with power supply inputs in the rear of the computer system 100." (Creason '150, col. 6 lines 12-14, emphasis added)

The Examiner also mischaracterized Creason '150 in order to "read" its subchassis (*carrier*) and backplane construction on *the carrier is operably slidingly engageable in the frontend partition toward the backplane to connect the common connector to the other side of the backplane* as claimed. A plain reading of Creason '150 reveals that the backplane 308 is attached to the subchassis 200. (see fasteners in exploded view of FIG. 3) As such, the backplane 308 is a part of the sub-chassis 200, so that the sub-chassis 200 does not matingly connect with the backplane when inserted into the chassis (*frontend partition*).

The Examiner has failed to substantiate a prima facie case of obviousness because Stamos '914 and Creason '150 do not, neither alone nor combined, teach or suggest all the

features of the present embodiments as recited by the language of claim 1. The examination resulting in the present obviousness rejection is incomplete with regard to the Examiner's obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a) Accordingly, this case is not in condition for appeal until this factual issue is resolved by the Examiner either withdrawing the obviousness rejection or substantiating it factually in the record.

The Examiner has also failed to substantiate a *prima facie* case of obviousness by failing to make a factual showing motivating a skilled artisan to combine and modify Stamos '914 and Creason '150 to arrive at the present embodiments as claimed. To that end the Examiner stated:

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the system of Stamos to include the teaching of supplying a multiple device array comprising a carrier and an alignment member, as taught by Creason, since the device of Creason would provide the system of Stamos with an independent carrier or sub-chassis for the multiple data storage devices of Stamos.
(Office Action of 3/20/2006, pg. 5)

Obviousness under Section 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*. A Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the legal conclusion of obviousness. *In re Gartside*. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *In re Lee*.

For a *prima facie* case of obviousness to exist, there must be an objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that

would lead an individual to combine the relevant teachings of the references. *In re Fine*. The motivation may come explicitly from statements in the prior art, from knowledge of one of ordinary skill in the art, or even in the nature of the problem to be solved. *Kotzab*, at 1370. The presence or absence of motivation is a question of fact, and the evidence that motivation exists must be clear and particular. *In re Dembiczak*.

Generalized statements of advantages or possibilities by an Examiner, without a bona-fide regard to the desirability or feasibility of modifying the cited references, does not meet the evidentiary requirements for substantiating a *prima facie* case of obviousness. Given the subtle but powerful attraction of a hindsight-based obviousness analysis, a rigorous application of the requirement of an evidentiary basis for the motivation must be followed. *In re Dembiczak*, at 999. In so doing the Examiner has at his disposal ample guidance:

The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art.

In re Ahlert, 424 F.2d 1088, 1091 (CCPA 1970)

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the application and other persons.

37 CFR 1.104(d)(2)

Assertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work...allegations concerning specific knowledge of the prior art, which might be peculiar to a particular art should also be supported....

In re Ahlert, at 1091

Applicant now reiterates that the only way the Examiner is able to supply a plurality of data storage devices that are electrically connected to a common connector, whereas the carrier is operably slidingly engageable in the frontend partition toward the backplane to connect the common connector to the other side of the backplane is via improper hindsight reconstruction. The Examiner has not pointed to any passage of either cited reference that supplies this limitation, or that motivates the skilled artisan to modify the cited references accordingly. The only place the Examiner can find this limitation is by using the Applicant's disclosure against it to extrapolate the misplaced generalizations from the related art.

In this case where the entirety of the legal conclusion of obviousness rests on the Examiner's generalizations, a Pre-Appeal Brief Panel must require some concrete evidence in the record to support them rather than relying on what the Examiner views to be "well recognized" or what a skilled artisan would be "well aware of." *In re Zurko*.

Accordingly, this case is not in condition for appeal due to the unresolved factual issue that the Examiner has relied exclusively on extrapolating beyond what the cited references reasonably teach or suggest with generalized statements of what "could be." These extrapolations are not substantiated by evidence in the record whatsoever as to them being obvious to the skilled artisan.

Because the rejection is based entirely upon facts within the personal knowledge of the Examiner, Applicant now respectfully requests, in accordance with the provisions of 37 CFR 1.104(d)(2), a substantiating affidavit so that the basis for the rejection might be made available for contradiction and explanation in Applicant's appeal.

Accordingly, this case is not in condition for appeal due to the unresolved factual issues that the Examiner has failed to substantiate any prima facie case whatsoever. Accordingly, for at least these reasons withdrawal of the final rejection of claim 1 and the claims depending therefrom is respectfully requested for further prosecution on the merits to completion.

Claim 17

Applicant traverses the rejection of claim 17 for the same reasons as discussed above for claims 1 and 9. The Examiner provides no additional explanation for the rejection of claim 17, rather it is combined with claim 1 in the Examiner's remarks.

As discussed above, Stamos '914 does not teach or suggest *attaching a backplane to a leading end of a backend partition* as claimed. Creason '150 does not cure this deficiency of Stamos '914 because it does not disclose a backend partition whatsoever, only the sub-chassis 200 into which all the components are inserted from the front side thereof.

Again, obviousness under Section 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*. A Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the legal conclusion of obviousness. *In re Gartside*. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *In re Lee*.

For a *prima facie* case of obviousness to exist, there must be an objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teachings of the references. *In re Fine*

The motivation may come explicitly from statements in the prior art, from knowledge of one of ordinary skill in the art, or even in the nature of the problem to be solved. *Kotzab*, at 1370. The presence or absence of motivation is a question of fact, and the evidence that motivation exists must be clear and particular. *In re Dembiczak*.

Generalized statements of advantages or possibilities by an Examiner, without a bona-fide regard to the desirability or feasibility of modifying the cited references, does not meet the evidentiary requirements for substantiating a *prima facie* case of obviousness. Given the subtle but powerful attraction of a hindsight-based obviousness analysis, a rigorous application of the requirement of an evidentiary basis for the motivation must be followed. *In re Dembiczak*, at 999.

Applicant now reiterates that the only way the Examiner is able to supply the *attaching a backplane to a leading end of a backend partition* limitation is via improper hindsight reconstruction. The Examiner has not pointed to any passage of either cited reference that supplies this limitation, or that motivates the skilled artisan to modify the cited references accordingly. The only place the Examiner can find this limitation is by using the Applicant's disclosure against it to extrapolate the misplaced generalizations from the related art.

In this case where the entirety of the legal conclusion of obviousness rests on the Examiner's generalizations, a Pre-Appeal Brief Panel must require some concrete evidence in the record to support them rather than relying on what the Examiner views to be "well recognized" or what a skilled artisan would be "well aware of." *In re Zurko*

Accordingly, this case is not in condition for appeal due to the unresolved factual issue that the Examiner has relied exclusively on extrapolating beyond what the cited

references reasonably teach or suggest with generalized statements of what "could be."

These extrapolations are not substantiated by evidence in the record whatsoever as to them being obvious to the skilled artisan.

Because the rejection is based entirely upon facts within the personal knowledge of the Examiner, Applicant now respectfully requests, in accordance with the provisions of 37 CFR 1.104(d)(2), a substantiating affidavit so that the basis for the rejection might be made available for contradiction and explanation in Applicant's appeal.

Accordingly, this case is not in condition for appeal due to the unresolved factual issues that the Examiner has failed to substantiate any prima facie case whatsoever. Accordingly, for at least these reasons withdrawal of the final rejection of claim 17 and the claims depending therefrom is respectfully requested for further prosecution on the merits to completion.

Conclusion

This is a complete response to the Office Action mailed March 20, 2006.

Applicant has also filed herewith a Request for Telephone Interview to be held before the Examiner makes the next action on the merits. In the event the Examiner does not grant the reconsideration requested herein, the interview is necessary to resolve the issues preventing this case from being in condition for appeal.

Should any questions arise concerning this response, the Examiner is encouraged to contact the below listed Attorneys.

Respectfully submitted,

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